

### Remarks

The applicant has amended the claims in response to the Official Communication. The applicant submits that the amended claims are in condition for allowance and respectfully requests the Office to move this case towards allowance.

Paragraphs 3, 5 and 7 of the Official Communication do not solicit a response in that they simply provide information.

In paragraphs 1-2 of the Official Communication, the Office states that the foreign patents and non-patent literature has not been considered because the parent application 09/385,671 was unavailable at the time of initial prosecution. The applicant requests additional information regarding this point. Because the references were included in a disclosure statement for the parent case, which was at the United States Patent Office, why was the parent application not available at the time of initial prosecution? Applicant respectfully requests the Office to consider these references and, because they were filed prior to the issuance of this Official Communication, no additional fees should be required for such consideration.

In paragraph 4 of the Official Communication, the Office provisionally rejects claims 1-12, 13-19 and 20 under 35 U.S.C. 101 as claiming the same subject matter as claim 1-12, 15-21 and 23 of copending U.S. Patent Application Serial Number 09/436,281. Claims 1-20 have been canceled without prejudice. The applicant reserves the right to continue prosecuting these claims but has canceled them at this point to accelerate the movement of this case towards allowance. The cancellation of these claims in no way is a concession that the arguments presented by the Office in support of a rejection of these claims are valid.

In paragraph 5 of the Official Communication, the Office rejected claims 21-25, 30-32, 34-38 40, 43, 50-55, 58-60, 65-72, 74-79, 98-105 and 109-110 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Number 5,619,247 to *Russo*.

Claims 21-29 have been canceled without prejudice. The applicant reserves the right to continue prosecuting these claims but has canceled them at this point to accelerate the movement of this case towards allowance. The cancellation of these claims in no way is a concession that the arguments presented by the Office in support of a rejection of these claims are valid.

Dependent claim 30 has been amended to become an independent claim and to include the elements of independent claim 21 from which it depended. As amended, claim 30 recites the element of transmitting additional information to the customer along with the plurality of the digital data content. In paragraph 6 of the Official Communication, the Office alleges that *Russo* teaches this element and cites column 3 line 15 of the patent. The applicant respectfully submits that *Russo* does not describe, suggest or teach this element of claim 30. *Russo* simply states that the recording of program materials may be directed automatically by subscriber-operated storage-management facilities, which could scan program schedules and select materials to be recorded, based on title, cast, program genre or preferences. This is not the same, nor is it even related to the transmission of additional information to the customer along with the digital data content. Therefore, the applicant respectfully submits that the amended claim 30 is in condition for allowance.

Claims 31-39 and 46-50 are dependent claims that depend either directly or indirectly from claim 30 which applicants have amended and resubmitted it as an allowable claim. The Office has rejected each of these claims citing various references in the *Russo*. The applicants do not concede that the arguments presented by the Office in support of a rejection of these claims

are valid; however, the applicants respectfully submit that because claims 31-39 depend from an allowable claim, that these claims are also in condition for allowance.

Dependent claim 40 has been amended to become an independent claim and to include the elements of independent claim 21 from which it depended. The Office admits that the cited references are silent as to the automatic selection of storage of additional information according to predetermined criteria where the criteria is user preferences. Applicant is confused as to why this claim and claims depending therefrom were not allowed because the Official Communication does not set forth any basis for the rejection of these claims. Thus, the applicant respectfully submits that amended claim 40 is in condition for allowance.

Claims 41-45 are dependent claims that depend either directly or indirectly from claim 40 which applicants have amended and resubmitted it as an allowable claim. The Office has rejected each of these claims citing various references in the *Russo*. The applicants do not concede that the arguments presented by the Office in support of a rejection of these claims are valid; however, the applicants respectfully submit that because claims 41-45 depend from an allowable claim, that these claims are also in condition for allowance.

Claim 50 has been amended to depend directly from claim 30, which applicants have resubmitted as an allowable claim. However, the rejection of this claim in the Official Communication is confusing. The rejection appears in paragraph 6 dealing with 35 U.S.C. 102 rejections but the Office states that the limitations have been addressed in the rejection of claim 4, which is discussed in paragraph 8 dealing with 35 U.S.C. 103 based rejections. Aside from this point, the applicants submit that although *Russo* teaches billing the customer, it is completely silent as to crediting the provider upon displaying of digital content. The applicants

submit that claim 50 is allowable over the cited art. Claim 50 also depends from allowable claim 30 and thus, should be allowed.

Claims 51-55, 58, 59, 65-106 and 109-110 have been canceled without prejudice. The applicant reserves the right to continue prosecuting these claims but has canceled them at this point to accelerate the movement of this case towards allowance. The cancellation of these claims in no way is a concession that the arguments presented by the Office in support of a rejection of these claims are valid.

With regards to claims 56-57, the Office takes Official Notice that using random processes and selecting based on popularity are well known in the art. The present invention takes advantage of the fact that content can be downloaded at no cost to the customer and the customer is only billed upon displaying the content. Thus, advantageously data can be downloaded that may interest the customer and the customer has the opportunity to decide whether or not to view this data before any charges are assessed. Applicant submits that the Official Notice that these techniques are prior art is incorrect. Although the techniques may exist in some form, the application of these techniques in the present invention is novel and unobvious. *Russo* is silent on the topic even though *Russo* is addressing many of the same problems. Thus, applicants respectfully submit that this rejection is traversed.

Claim 60 describes the inclusion of classification information in the digital content and then selecting other content based on the classification information. The Office alleges that this is described in *Russo* citing column 3, lines 12-16 of the patent. Applicants have reviewed this reference in detail and fail to find any description of this element. *Russo* simply does not describe, suggest or teach the transmission of such information to the play back device.

Therefore, applicants respectfully submit that claim 60 is allowable and respectfully requests the Office to retract this rejection.

Claims 61-64, the Office takes Official Notice that deleting the oldest stored data, older released data, or least fit preferences of the customer are well known in the art. The applicant traverses this rejection. These features are uniquely applied in the present invention in a system that downloads more content than may be necessary or desired by the customer. To allow the customer to maintain a supply of fresh, or recent material, certain criteria are applied to the stored digital content to allow newer material to overwrite older material. This application of this technology is a novel step.

In paragraph 8 of the Official Communication, the Office rejects claim 1-4 and 14 under 35 U.S.C. 103(a) as being unpatenable over Russo in view of U.S. Patent Number 4,789,863 to *Bush*.

Claims 1-4 and 14 have been canceled as stated above.

In paragraph 9 of the Official Communication, the Office rejects claim 26-29, 46-49, 56, 57, 61-64, 95, and 106-108 under 35 U.S.C. 103(a) as being unpatentable over *Russo*.

Claims 26-29, 95 and 106 have been canceled as stated above.

Claims 46-49 have been addressed in above. However, the Office takes Official Notice that detecting and repairing errors, retransmission of data, and customer notifications are well known in the art. In the present invention, video data is delivered to a customer for storage. The customer is not billed for this video data until the customer actually views the video data. Claims 46-49 deal with detecting and notifying a customer of errors that may be present in the video data. It is important for the user to know this information to facilitate making the decision to download a new copy, or run the risk of viewing the copy as is and then being billed for viewing

the copy. Applicants submit that the Official Notice that these techniques are prior art is incorrect. Although the techniques may exist in some form, the application of these techniques in the present invention is novel and unobvious. *Russo* is silent on the topic even though *Russo* is addressing many of the same problems. Thus, applicants respectfully submit that this rejection is traversed.

Dependent claims 56 and 57 formerly depended from independent claim 51 have been amended to include the elements of claim 51 and to be placed in independent form. The Office has taken Official Notice that using random processes and selection based on popularity are well known in the art. Applicants submit that the Official Notice that these techniques are prior art is incorrect. Although the techniques may exist in some form, the application of these techniques in the present invention is novel and unobvious. *Russo* is silent on the topic even though *Russo* is addressing many of the same problems. Thus, applicants respectfully submit that this rejection is traversed.

Dependent claims 61-64 have been amended to depend from claim 57. Applicants have submitted that claim 57 is allowable, thus, these claims are also allowable. In addition, applicant respectfully traverses the Office's Official Notice that the elements cited in these claims are well known in the art. Although the techniques may exist in some form, the application of these techniques in the present invention is novel and unobvious. *Russo* is silent on the topic even though *Russo* is addressing many of the same problems. Thus, applicants respectfully submit that this rejection is traversed.

Dependent claims 107 and 108 formerly depended from independent claim 98 have been amended to include the elements of claim 98 and to be placed in independent form. The Office has taken Official Notice that using random processes and selection based on popularity are well

known in the art. Applicants submit that the Official Notice that these techniques are prior art is incorrect. Although the techniques may exist in some form, the application of these techniques in the present invention is novel and unobvious. *Russo* is silent on the topic even though *Russo* is addressing many of the same problems. Thus, applicants respectfully submit that this rejection is traversed.

In paragraph 10 of the Official Communication, the Office rejects claim 33, 41, 44-45 and 96-97 under 35 U.S.C. 103(a) as being unpatentable over *Russo* in view of U.S. Patent Number 6,177,931 to *Alexander et al.* Claim 33 depends from claim 30 and claims 41 and 44-45 depend from claim 40. These claims have been discussed above. Claims 96-97 have been canceled as stated above.

In paragraph 11 of the Official Communication, the Office rejects claims 39, 42 and 73 under 35 U.S.C. 103(a) as being unpatentable over *Russo* in view of U.S. Patent Number 6,522,769 to *Rhoads et al.* Claim 39 depends indirectly from claim 30 and claim 42 depends from claim 40. These claims have been discussed above. Claim 73 have been canceled as stated above.

In paragraph 12 of the Official Communication, the Office rejects claims 5-6 and 24 under 35 U.S.C. 103(a) as being unpatentable over *Russo* in view of *Bush* in view of U.S. Patent Number 4,809,325 to *Hayashi et al.* Claims 5-6 and 24 have been canceled as stated above.

In paragraph 13 of the Official Communication, the Office rejects claims 7-12 under 35 U.S.C. 103(a) as being unpatentable over *Russo* in view of *Bush* in view of U.S. Patent Number 5,610,653 to *Abecassis*. Claims 7-12 have been canceled as stated above.

In paragraph 14 of the Official Communication, the Office rejects claim 20 under 35 U.S.C. 103(a) as being unpatentable over Russo in view of *Bush* in view of U.S. Patent Number 5,438,355 to *Palmer*. Claim 20 has been canceled as stated above.

In paragraph 15 of the Official Communication, the Office rejects claims 13-17 under 35 U.S.C. 103(a) as being unpatentable over Russo in view of *Bush* in view of *Palmer*, *Hayashi* and *Abecassis*. Claims 13-17 have been canceled as stated above.

In paragraph 16 of the Official Communication, the Office rejects claims 18-19 under 35 U.S.C. 103(a) as being unpatentable over Russo in view of *Bush* in view of *Palmer*, *Hayashi* and *Abecassis* and U.S. Patent Number 5,621,840 to *Kawamura et al.* Claims 18-19 have been canceled as stated above.

The applicants have addressed each of the rejections set forth in the Official Communication. Claims 1-29, 51-55, 58-59, 65-106 and 109-110 have been canceled without prejudice. Applicants submit that the remaining claims, claims 30-50, 56, 57, 60-64 and 107-108, are in condition for allowance and requests the Office to move this case towards allowance.